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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,427	07/07/2003	Neil Andrew Abercrombie Simpson	MRKS/0091	7722

7590 10/21/2005

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EXAMINER

NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/614,427		ABERCROMBIE SIMPSON ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	William P. Neuder		3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10,13-35,37-43,55-58,61-64,66-72,81-87 and 93-98 is/are pending in the application.
- 4a) Of the above claim(s) 96-98 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,8,10,13-35 and 38-43 is/are allowed.
- 6) ☒ Claim(s) 37,55-58,61,62,64,66-71,81-87 and 93-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*Ch*

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**DETAILED ACTION**

***Election/Restrictions***

**DETAILED ACTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6,8,10,13-35,37-43,55-58,61-64,66-72,81-87 and 93-95, drawn to well bore tubulars and methods of use, classified in class 166, subclass 384.
- II. Claim 96, drawn to a method of cementing, classified in class 166, subclass 285.
- III. Claim 97, drawn to a method of cleaning a bore, classified in class 166, subclass 311.
- IV. Claim 98, drawn to a tractor, classified in class 175, subclass 99.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group I does not require a tractor or a method of cementing or cleaning and has separate utility such as in lining a well. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III and IV, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Newly submitted claims 96-98 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: See above

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 96-98 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Objections***

Claim 86 is objected to because of the following informalities: Claim 86 depends from itself. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 55-58, 67, 69, 70, 81-85, 87 and 93 – 95 are rejected under 35 U.S.C. 102(b) as being anticipated by Simmons (1880218).

Simmons discloses a method of running tubing into a well while minimizing sticking (see page 2, lines 10-43). Corrugated tubing D is run into the well. As to claim 56, the corrugated tubing is rotated while being run into the well. As to claim 57, a plurality of tubing sections D are joined by relatively rigid connections Da. As to claim 58, sediment would be dislodged from the bore by rotation of the corrugated tubing. As to claim 67, rigid connectors Da are corrugated as well. As to claim 69, the corrugations are circumferential. As to claim 70, the corrugated end portions are parallel. As to claim 81, the corrugated tube is placed in a larger diameter well and then expanded into contact with the well reducing the degree of tension applied to the tubular allowing the tubular to axially contract and radially expand. As to claim 82, prior to expansion, the tubing is under tension. As to claim 83, once expansion begins the tubing is being placed in compression. As to claim 84, the tubing is expanded into contact with the borehole wall. As to claim 85, tubing D has corrugations to accommodate a degree of compression and expansion. As to claim 87, corrugated tubing is expanded without the tubing substantially changing its length. As to claim 93, bit B is carried by tubing D for

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drilling the well. As to claim 94, tubing D is considered corrugated casing. As to claim 95, the tubing is expanded.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simons (described above).

It would have been considered an obvious design choice to form the tubular ends tapered as opposed to parallel since no degree of criticality has been presented for forming the ends tapered.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (described above) in view of Ohirano et al 6431610.

Simmons is considered to disclose all of the claimed features except for annealing the corrugated tubing. Ohirano et al teaches annealing corrugated tubing to prevent corrosion. It would have been considered obvious to anneal the corrugated tubing of Simmons as taught by Ohirano for the purpose of preventing or deterring corrosion.

Claims 61,62,64 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (described above) in view of Zifferer 2002/0121361.

Simmons is considered to disclose all of the claimed features except for the corrugations being helical. Zifferer teaches that it is known to form corrugated tubing having either helical or linear corrugations. It would have been considered obvious to form the corrugations of Simmons helical in view of Zifferer's teaching that helical or linear corrugations are equivalents. As to claim 62, the corrugated tubing D is rotated while advancing the tubing into the well. As to claim 64, rotating the tubing would allow the tubing to negotiate any tight spots.



Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richard et al 6263972 in view of Simmons (described above).

Richard et al discloses using reelable corrugated tubing. Richard does not teach the corrugations having selected periodic corrugations. Simmons teaches corrugated tubing having selected periodic corrugations. It would have been considered obvious to use selected periodic corrugation in the tubing of Richard et al as taught by Simmons so that one known the exact strength of the tubing.

***Allowable Subject Matter***

Claims 63 and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-6,8,10,13-35 and 38-43 are allowed.

***Response to Arguments***

Applicant's arguments with respect to claims 37,55-58,61,62,64,66-71,81-85,87 and 93-95 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William P Neuder  
Primary Examiner  
Art Unit 3672

W.P.N.